



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/909,194 | 07/19/2001 | Michael A. Wilkman | HOLCORP.005A | 9144 |

20995 7590 08/23/2007
KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

| |
|----------|
| EXAMINER |
|----------|

CHAMPAGNE, DONALD

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3622

| | |
|-------------------|---------------|
| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

08/23/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
eOAPilot@kmob.com

Office Action Summary

Application No.

09/909,194

Applicant(s)

WILKMAN, MICHAEL A.

Examiner

Donald L. Champagne

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-13, 15, 19 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-13, 15, 19 and 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 6 June 2007 have been fully considered but they are not persuasive. The arguments are addressed revision of the last rejection (mailed on 8 March 2007).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 24-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. At claim 24, lines 5-6, "a user transaction manager configured to manage ... a user's interests" is new matter.
4. Claims 24-27 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the remainder of the claims, does not reasonably provide enablement for "a user transaction manager configured to manage ... a user's interests" (claim 24, lines 5-6). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. It is not clear how a computer manages a person's interests.
5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At line 2, "the plurality of user accounts" lacks antecedent basis.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-6, 8-13, 15, 19 and 24-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Meyer et al. (US005644723A).
9. Meyer et al. teaches (independent claim 8) a method for managing promotions, comprising:
- receiving, via an electronic communications medium, a plurality of promotions relating to a plurality of merchants (col. 9 lines 56-59 and col. 1 line 29);
- receiving, via an electronic communications medium, user information relating to a plurality of *members/users*, wherein the *member/user* information includes *member/user* payment (i.e., *Visa credit card*) account information (col. 17 lines 15-27, col. 33 lines 10-14, including Fig. 22, item **2211**, and col. 41 lines 22-26);
- matching at least one of the plurality of promotions to at least one of the plurality of *members/users* based at least upon a portion of the plurality of *member/user* information (col. 46 lines 20-42) and user payment account information (col. 24 line 1-8); and
- presenting to at least one of the plurality of *members/users*, via a personal computer device (col. 7 lines 55-57), information in a promotion document about the at least one of the plurality of promotions (col. 6 lines 34-43).
10. Meyer et al. also teaches (independent claim 1) a user/*member* credit card account for each of a plurality of users/*members* (col. 17 lines 15-27, col. 33 lines 10-14, including Fig. 22, item **2211**, and col. 41 lines 22-26), which reads on a plurality of user accounts for transferring funds, and a transaction module configured to select that one user/*member's* account for a commercial transaction (col. 41 lines 31-36) by said user/*member*, wherein the

Art Unit: 3622

selection is based in part on the rules that govern which one of the plurality of user accounts should be used (the rule being to use the account belonging to the user/*member* to whom the promotion is to be provided).

11. Meyer et al. also teaches (independent claim 24) a transaction module (*incentive information computer 105*, col. 18 lines 18-20) to present information (*incentive existence message*, col. 7 lines 39-46) about the selected one or more promotions to the user.
12. Meyer et al. also teaches at the citations given above claims 3, 5, 6, 11-13, 15, 19 and 26.
13. Meyer et al. also teaches: claims 2 and 25 (where registration of the promotion agencies, col. 48 lines 40-42, or registration of the promotion, col. 27 lines 49-53, or the *promotion sponsors* contracting with the *service provider*, col. 20 lines 16-18, read on registering a plurality of merchants, and *logging all transactions*, col. 50 lines 8-9, reads on track merchant billing information); claims 4 and 27, where the transaction manager selects the credit card required for *external membership* (col. 17 lines 15-27); claim 9 (col. 8 line 39); and claim 10 (col. 3 line 46 and col. 53 lines 35-43).

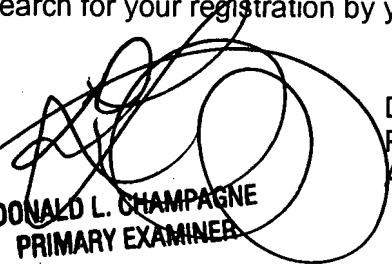
Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
15. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.
16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 3622

17. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

16 August 2007


DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622